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Paper No. 6

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APR 23 2004

**OFFICE OF PETITIONS
ON PETITION**

In re Application of :
Walcott :
Application No. 10/052,865 :
Filed: January 17, 2002 :
Attorney Docket No. 1391 :

This is a decision on the petition under 37 CFR 1.137(a), filed April 12, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Facts:

The application was improperly filed without an abstract.

On February 14, 2002, a Notice to File Corrected Application Papers was sent to petitioner.

Corrected papers were not submitted and the application became abandoned on April 15, 2002.

A Notice of Abandonment was mailed on January 21, 2004.

Analysis:

A grantable petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply,
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee *if* the application was filed on or before June 8, 1995 or *if* the application is a design application.

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard

35 USC 133 states, "Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable." (emphasis added)

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference."¹

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."² The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"³

Petitioner cites docketing errors as the cause of the abandonment of the application. The instant petition is not the first filed by the attorney seeking to revive an application for clerical/docketing errors. Application No. 09/502,401 went abandoned when the attorney failed to timely pay the issue fee and submit drawings. Petitioner filed a petition under 37 CFR 1.137(a) alleging the existence of a reliable system to ensure applications would not become abandoned. The petition was eventually granted. A similar petition under 37 CFR 1.378(b) was filed and eventually granted for patent number 5,423,098.

A **partial** review of the attorney's cases indicates the following applications have at one time or another become abandoned and the following patents have become expired:

10/388,807
10/313,843 (a petition under 37 CFR 1.137(b) was filed and granted)
09/967,529
09/766,172
09/709,881
09/580,061
09/549,076
09/406,471
09/358,799
09/352,276
09/215,808

¹ Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³ See In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912).

09/052,535 (abandoned more than once)
09/019,529
08/932,654
08/898,507
08/897,257
08/888,584
08/821,820
6,050,625 (not clear if this has expired)
5,818,672
6,084,165
5,724,434
5,737,123
5,596,371
5,533,132
5,499,154
5,664,023
5,561,583
5,486,914

Petitioner should list which of the applications or patents above were intentionally allowed to become abandoned or to expire. For the remainder, petitioner should compare and contrast the abandonment or expiration with the facts for the instant application.

Application of the standard to the current facts and circumstances

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$665 for a small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

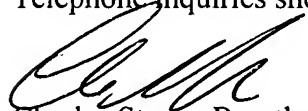
By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



Charles Steven Brantley
Petitions Attorney
Office of Petitions